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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* WILLIAM ALLOCCA, JORDAN HAY, JONATHAN A.
9 LEBLANG, COLLEEN MCQUEEN, and JAMES PRUDENTE
10

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12 Appeal 2008-4062
13 Application 09/547,540
14 Technology Center 3600
15

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17 Decided: January 26, 2009
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20 *Before* HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
21 MOHANTY, *Administrative Patent Judges*.

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23 FETTING, *Administrative Patent Judge*.

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25 DECISION ON APPEAL

26
27 STATEMENT OF THE CASE

28
29 William Allocca, Jordan Hay, Jonathan A. Leblang, Colleen
30 McQueen, and James Prudente (Appellants) seek review under
31 35 U.S.C. § 134 of a final rejection of claims 1-10, 13-27, 29-33, 35-38, 40,
32 41, 50-65, 67, 68, and 129, the only claims pending in the application on
33 appeal.

1 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

2
3 We AFFIRM.

4 The Appellants invented a way of ordering items over the internet
5 (Specification 1:8-10) using a Selection Of Procurement Option. When the user
6 selects a procurement option to complete the ordering of the item (e.g., by
7 performance of a single action), the system retrieves the procurement option
8 information for the selected procurement option and uses that information to
9 complete the ordering of the item. For example, the initially generated Web page
10 may contain a displayed element that, when selected, proceeds to display the
11 various available procurement options (Specification 37:9-18). An understanding
12 of the invention can be derived from a reading of exemplary claims 1 and 29,
13 which are reproduced below [bracketed matter and some paragraphing added].

14 1. A method for a user at a client system to place an order for an item,
15 the user having a plurality of groups of predefined order fulfillment
16 information, the method comprising:

17 [1] displaying at the client system information identifying the item;

18 [2] displaying at the client system an element representing order
19 fulfillment instructions for the identified item;

20 [3] receiving indications of multiple groups of order fulfillment
21 information

22 that are each predefined for the user and

23 that each include a unique combination of

24 a delivery address,

25 shipping instructions distinct from the delivery address,

26 and a payment source;

27 [4] when the displayed element is selected by the user,

28 displaying at the client system an indication of each of the
29 identified multiple groups; and

30 [5] after selection by the user of a displayed indication of one of the
31 identified multiple groups and
32 without further intervention by the user,

1 sending to a server computer a request to order the identified
2 item such that the identified item
3 is to be sent to the delivery address for the selected
4 indicated group using the shipping instructions for the
5 selected indicated group and
6 is to be paid for by the payment source for the selected
7 indicated group,
8 so that a single action of selecting a group of order
9 fulfillment information
10 orders and pays for the item.

11
12 29. A computer-readable medium whose contents cause a computer
13 system to order an item using a client system, by performing a method
14 comprising:
15 [1] displaying information identifying the item;
16 [2] for each of multiple procurement options that each have information
17 related to ordering that includes at least delivery information and
18 information regarding payment,
19 displaying an indication of the procurement option such that selection
20 of the displayed indication represents using the information of the
21 procurement option for ordering of the identified item; and
22 [3] after selection of a displayed indication, sending to a server system a
23 request to order the identified item using the information of the
24 procurement option for the selected indication.

25
26 This appeal arises from the Examiner's Final Rejection, mailed July 8, 2003.
27 The Appellants filed an Appeal Brief in support of the appeal on December 8,
28 2003, and the Examiner reopened prosecution with another Final Rejection, mailed
29 March 2, 2004. The Appellants filed a Supplemental Brief on June 2, 2004 and the
30 Examiner mailed an Examiner's Answer to the Appeal Brief and Supplemental
31 Brief on May 2, 2006. A Reply Brief was filed July 3, 2006. The Examiner mailed
32 a replacement Examiner's Answer on September 14, 2006 to comply with a
33 requirement that the references of record be listed. The Appellants filed a
34 Supplemental Reply Brief, consisting solely of a request that the prior Reply Brief

and its accompanying request for oral hearing be considered as responsive, on November 14, 2006.

The Appellants filed another Supplemental Reply Brief on Aug. 27, 2007 to comment on the patentability of their claims after *KSR*. This was not in response to an Examiner's Answer, and therefore was not in compliance with 37 C.F.R. § 41.41(a). Accordingly, the appeal was remanded to the Examiner. The Examiner mailed a Supplemental Answer that added to, but did not replace, the September 14, 2006 Answer, on November 13, 2007. The Appellants filed another Reply Brief on January 8, 2008.

Thus, generic references in this opinion to the Appeal Brief refer to the December 8, 2003 filing, generic references to the Reply Brief refer to the January 8, 2008 filing, and generic references to the Examiner's Answer refer to the Sep. 14, 2006 mailing. References to the Supplemental Answer refer to the November 13, 2007 Supplemental Answer.

PRIOR ART

The Examiner relies upon the following prior art:

Hartman	US 5,960,411	Sep. 28, 1999
Yamada	US 6,336,100 B1	Jan. 1, 2002
Holland	US 6,493,742 B1	Dec. 10, 2002

REJECTIONS¹

Claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman and Yamada.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Official Notice.

Claims 14 and 36 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Holland.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 under 35 U.S.C. § 103(a) as unpatentable over Hartman and Yamada.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claim 8 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Official Notice.
- Whether the Appellants have sustained their burden of showing that the Examiner erred in rejecting claims 14 and 36 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Holland.

The pertinent issue turns on whether the art describes or it was otherwise predictable to provide, for each of multiple procurement

¹ The Appellants respond to a rejection under 35 U.S.C. § 112, first paragraph (App. Br. 27; ¶ C.), but the Examiner indicated such a rejection had previously been withdrawn (Answer 3: Status of Claims).

options that each have information related to ordering that includes at least delivery information and information regarding payment, displaying an indication of the procurement option such that selection of the displayed indication represents using the information of the procurement option for ordering of the identified item.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Hartman

01. Hartman is directed to a one-click ordering of an item from a client system. The client system is provided with an identifier that identifies a customer. The client system displays information that identifies the item and displays an indication of an action (e.g., a single action such as clicking a mouse button) that a purchaser is to perform to order the identified item. In response to the indicated action being performed, the client system sends to a server system the provided identifier and a request to order the identified item. The server system uses the identifier to identify additional information needed to generate an order for the item and then generates the order (Hartman 2:51-62).
02. Purchaser-specific order information may include the purchaser's name, the purchaser's credit card number, and a shipping address for the order (Hartman 1:60-62). Such information may also include a shipping method and payment method (Hartman Fig. 1C:108; Hartman 6:1-3).
03. Purchaser specific information may be saved at a web site to prefill the next order (Hartman 2:34-36).

04. Hartman describes displaying partial purchaser-specific order information on the ordering page. This information may include a shipping address moniker selected by the purchaser and credit card number digits (Hartman 7:8-13).

05. Hartman's server system can map a client identifier to multiple customers who have recently used the client system. The server system can then allow the users to identify themselves by selecting one of the mappings based on a display of partial purchaser-specific order information (Hartman 9:58-63).

Yamada

06. Yamada is directed to an online shopping system in which a customer can designate addresses or places where he or she wants to have goods delivered (Yamada 1:19-22).

07. Yamada displays a list of destination addresses for a customer to select from (Yamada Fig. 9) and the selected destination is used for an order (Yamada Fig. 10).

Holland

08. Holland is directed to aggregating registries. Holland allows registrants to collect all registries, both custom and retail-specific, in a single web site (Holland 2:25-29).

Facts Related To The Level Of Skill In The Art

09. Neither the Examiner nor the Appellants has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, user interfaces, and commercial sales transaction systems. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355

(Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

10. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004).

Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the specification” without importing limitations from the specification into the claims unnecessarily).

Although a patent applicant is entitled to be his or her own lexicographer of patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such definitions in the Specification with sufficient clarity to provide a person of ordinary skill in the art with clear and precise notice of the meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the specific terms used to describe the invention, this

1 must be done with reasonable clarity, deliberateness, and precision; where an
2 inventor chooses to give terms uncommon meanings, the inventor must set out any
3 uncommon definition in some manner within the patent disclosure so as to give
4 one of ordinary skill in the art notice of the change).

5
6 *Obviousness*

7 A claimed invention is unpatentable if the differences between it and the
8 prior art are “such that the subject matter as a whole would have been obvious at
9 the time the invention was made to a person having ordinary skill in the art.” 35
10 U.S.C. § 103(a) (2000); *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1729-30
11 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

12 In *Graham*, the Court held that the obviousness analysis is bottomed on
13 several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
14 determined; [(2)] differences between the prior art and the claims at issue are to be
15 ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.” 383
16 U.S. at 17. *See also KSR*, 127 S. Ct. at 1734. “The combination of familiar
17 elements according to known methods is likely to be obvious when it does no more
18 than yield predictable results.” *Id.* at 1739.

19 “When a work is available in one field of endeavor, design incentives and
20 other market forces can prompt variations of it, either in the same field or a
21 different one. If a person of ordinary skill can implement a predictable variation, §
22 103 likely bars its patentability.” *Id.* at 1740.

23 “For the same reason, if a technique has been used to improve one device,
24 and a person of ordinary skill in the art would recognize that it would improve
25 similar devices in the same way, using the technique is obvious unless its actual
26 application is beyond his or her skill.” *Id.*

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman and Yamada .

The Appellants created an 18 member grouping to which the Appellants apply six arguments in support of patentability, each such argument, except for one, B.3, is applied to plural such groups. The Appellants nominate the first argument as A, the second, third, fourth, and fifth as B.1, B.2, B.3, and B.4, and the sixth as C. The sixth argument C, refers to a rejection under 35 U.S.C. § 112, first paragraph, in the Jul. 8, 2003 Final Rejection. Argument C is moot because this rejection was withdrawn by the Examiner in the Mar. 2, 2004 Final Rejection.

Argument B.3 applies to claim 18 alone, and is discussed, *infra*. Arguments A, B.1, B.2, and B.4 all apply to the group the Appellants designated as group 2, which includes claim 1. Each of these arguments apply to other groups as well, but since each argument applies to a group of groups, each argument applies to all of the claims in those collective groups, which always includes claim 1. Therefore, each of the Appellant’s arguments applied to this rejection are applied to claim 1, and therefore the Appellants have made arguments A, B.1, B.2, and B.4 against claim 1. Accordingly, since claim 1 is representative of each of the groups of groups made by the Appellants, we find that the Appellants have argued these claims as a group and stand or fall with claim 1.

Claim 1

1 The Appellants apply this contention to claims 1-10, 13-27, 29-33, 35-38,
2 40-41, 50-63 and 129, which the Appellants have designated as Groups 1-8 and 11-
3 18 in their grouping of claims.

4 We disagree with the Appellants. Hartman describes requiring procurement
5 options to complete an order, and those options may include payment information
6 and delivery information (FF 01-04). Hartman further describes predefining such
7 options (FF 03) and mapping users to sets of partial purchaser-specific order
8 information with client identifiers (FF 05). Thus, each such client identifier maps
9 to a procurement option having associated information of multiple types including
10 at least payment information and delivery information. Although Hartman
11 characterizes the codes that identify each set of partial purchaser-specific order
12 information as client identifiers, these identifiers may be selected by the current
13 system user (FF 05) and thus operate as a collection of partial purchaser-specific
14 order information identifiers for a given user.

15 The Appellants contend there is no proper motivation to combine the
16 techniques from Hartman and Yamada, and even if there were such a motivation, a
17 combination of Hartman and Yamada would result in a system in which a user can
18 select to use a single previously provided delivery address and financial
19 information to order an item with a single action, or in which a user can select
20 among multiple predefined delivery addresses when ordering items from a
21 shopping cart, such as by also manually specifying payment information to be used
22 alter selecting one of the predefined delivery addresses. (Br. 16).

23 We again disagree with the Appellants. Yamada provides data entry
24 implementation details useful to Hartman's sales system, including suggested data
25 entry screens for purchase information such as Hartman's destination information
26 (FF 07). As to the resulting combination of the references, "[t]he test for

obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). One of ordinary skill would have known that Yamada's screen for selecting destination options described an implementation for Hartman's selection of codes representing groups of partial purchaser-specific order information.

Appellant's Argument B1

The Appellants contend that none of the cited references teaches or suggests that the predefined procurement options include "shipping instructions" for use in delivering ordered items in addition to the delivery and payment information (Br. 17-19). The Appellants apply this contention to claims 1-9, 13, 35, and 51, which the Appellants have designated as Groups 1, 2, 5, 8, and 16 in their grouping of claims.

We disagree with the Appellants. Since we found *supra* that Hartman described presenting a group of procurement options, the only issue here is whether Hartman suggested including shipping instructions in such options. Hartman explicitly shows including shipping instructions in the form of a shipping method in such options, at least at the data entry level (FF 02).

Appellant's Argument B2

The Appellants contend that none of the cited references teaches or suggests that each of the predefined procurement options includes a "unique combination" of a delivery address, shipping instructions, and a payment source or each has a "distinct combination" of multiple types of information that is "sufficient to

1 complete an order" for an identified item (Br. 19-21). The Appellants apply this
2 contention to claims 1-8, 10, 13-27, 33, 35-38, and 50-55, which the Appellants
3 have designated as Groups 2-8, 14, and 16 in their grouping of claims.

4 We disagree with the Appellants. We found *supra* that the references
5 suggest that each of the predefined procurement options includes a combination of
6 a delivery address, shipping instructions, and a payment source. As there is no
7 point in entering redundant such combinations, one of ordinary skill would have
8 known that generally such combinations would be unique. Hartman describes
9 selecting such an option (FF 05) and then selecting a product such that the
10 combination is sufficient to complete an order (FF 01). One of ordinary skill
11 would have known that because the combination of these two steps provided the
12 information necessary for the order, the steps could have been reversed, and the
13 sequence preferred would simply depend on whether one desired to retain or not
14 retain the ordering options when selecting multiple items. In such a case it would
15 have been the selection of the purchase options rather than the item that was
16 sufficient to complete the order at that stage.

17
18 *Appellant's Argument B4*

19 The Appellants contend that none of the cited references teaches or suggests
20 that the user can order an item using the item ordering information associated with
21 one of multiple predefined procurement options by merely selecting the displayed
22 indication for that procurement option (Br. 24-27). The Appellants apply this
23 contention to claims 1-9, 33, 35-38, and 64-68, which the Appellants have
24 designated as Groups 1, 2, and 6-10 in their grouping of claims.

25 We disagree with the Appellants. We found *supra* that Hartman describes
26 selecting such an option (FF 05) and then selecting a product such that the

1 combination is sufficient to complete an order (FF 01). One of ordinary skill
2 would have known that because the combination of these two steps provided the
3 information necessary for the order, the steps could have been reversed, and the
4 sequence preferred would simply depend on whether one desired to retain or not
5 retain the ordering options when selecting multiple items. In such a case it would
6 have been the selection of the purchase options rather than the item that was
7 sufficient to order the item at that stage.

8
9 *Claim 18*

10 *Appellant's Argument B3*

11 The Appellants contend that none of the cited references teaches or suggests
12 interactive creation of a new procurement option for use in ordering the item (Br.
13 21-24). The Examiner found that Yamada described creating a new procurement
14 option in response to selecting a particular city, such as New York, which in turn
15 provided options attributable to that city for the user to select from. We agree with
16 the Examiner. Claim 18 does not further narrow the manner in which the option is
17 created. Creating based upon examples, such as cities in Yamada is still an act of
18 creating.

19 The Appellants have not sustained their burden of showing that the
20 Examiner erred in rejecting claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41,
21 50-65, 67-68, and 129 under 35 U.S.C. § 103(a) as unpatentable over Hartman and
22 Yamada.

*Claim 8 rejected under 35 U.S.C. § 103(a) as unpatentable over Hartman,
Yamada, and Official Notice.*

The Appellants present no argument specific to claim 8, and so have not sustained their burden of showing that the Examiner erred in rejecting claim 8 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Official Notice.

*Claims 14 and 36 rejected under 35 U.S.C. § 103(a) as unpatentable over
Hartman, Yamada, and Holland.*

The Appellants present no arguments specific to claims 14 and 36, and so have not sustained their burden of showing that the Examiner erred in rejecting claims 14 and 36 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Holland.

CONCLUSIONS OF LAW

The Appellants have not sustained their burden of showing that the Examiner erred in rejecting claims 1-10, 13-27, 29-33, 35-38, 40, 41, 50-65, 67, 68, and 129 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-7, 9-10, 13, 15-27, 29-33, 35, 37-38, 40-41, 50-65, 67-68, and 129 under 35 U.S.C. § 103(a) as unpatentable over Hartman and Yamada is sustained.
- The rejection of claim 8 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Official Notice is sustained.

- The rejection of claims 14 and 36 under 35 U.S.C. § 103(a) as unpatentable over Hartman, Yamada, and Holland is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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